



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/917,331

07/27/2001

Charles O. Rock

1340-1-032N

1240

28172

7590

06/16/2004

BUTLER, SNOW, O'MARA, STEVENS & CANNADA PLLC
6075 POPLAR AVENUE
SUITE 500
MEMPHIS, TN 38119

EXAMINER

STEADMAN, DAVID J

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,331

Applicant(s)

ROCK ET AL.

Examiner

David J Steadman

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Status of the Application

- [1] Claims 1-25 are pending in the application.

Election/Restrictions

- [2] Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-3 and 7-8, drawn to a crystal of a binding complex between beta-ketoacyl-ACP synthase I (FabB) and thiolactomycin (TLM) and a method for obtaining a crystal of an inhibitor-FabB complex, classified in class 435, subclass 193.
- II. Claims 4-8, drawn to a crystal of a binding complex between FabB and cerulenin and a method for obtaining a crystal of an inhibitor-FabB complex, classified in class 435, subclass 193.
- III. Claim 9, drawn to a computer comprising within its memory a representation of the binding complex between FabB and cerulenin or a portion thereof, classified in class 702, subclass 27.
- IV. Claim 10, drawn to a computer comprising within its memory a representation of the binding complex between FabB and TLM or a portion thereof, classified in class 702, subclass 27.
- V. Claims 11, 13-15, and 19-25, drawn to a method of identifying an agent for use as an inhibitor of bacterial fatty acid synthesis using

atomic coordinates obtained from a FabB-TLM crystal, classified in class 702, subclass 27.

VI. Claims 12 and 16-25, drawn to a method of identifying an agent for use as an inhibitor of bacterial fatty acid synthesis using atomic coordinates from a FabB-cerulenin crystal, classified in class 702, subclass 27.

VII. Claims 19-25, drawn to a method of identifying an agent for use as an inhibitor of bacterial fatty acid synthesis using atomic coordinates obtained from a FabB-TLM crystal AND a FabB-cerulenin crystal, classified in class 702, subclass 27.

[3] The inventions are distinct, each from the other because:

[4] The crystals of Groups I-II comprise structurally distinct molecules and no single crystal of Groups I-II would render the other obvious to one of ordinary skill in the art.

[5] The computers of Groups III-IV comprise different data sets and no single computer of Groups III-IV would render the other obvious to one of ordinary skill in the art.

[6] The crystals of Groups I-II or the computers of Groups III-IV and the methods of Groups V-VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the

instant case, the crystals can be used for the determination of the structures of FabB enzyme complexes and the computers can be used for word processing.

[7] Inventions V and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each of inventions V and VI has separate utility as evidenced by their being claimed independently. See MPEP § 806.05(d).

[8] Inventions V or VI and VII are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed as evidenced by the alternative expression, i.e., and/or, recited in the independent claims. The subcombination has separate utility as evidenced by its being claimed independently.

[9] MPEP § 803 sets forth two criteria for a proper restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed and (B) There must be a serious burden on the examiner. As shown above, each of the inventions of Groups I-VII are independent or distinct, thus satisfying the first criterion for a proper restriction. MPEP § 803 additionally states that a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification,

separate status in the art, or a different field of search. Each of the inventions requires a separate patent and non-patent literature search requiring a different text search for each Group and thus, co-examination of the inventions of Groups I-VII would require a serious burden on the examiner.

[10] Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

[11] Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

[12] It is noted that claims 7-8 and 19-25 have been included in multiple groups. The claims will be examined only to the extent that they read on the elected subject matter.

Rejoinder

[13] The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims

that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

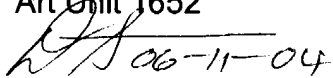
In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Art Unit: 1652

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (571) 272-0942. The Examiner can normally be reached Monday-Friday from 7:30 am to 4:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (571) 272-0928. The FAX number for submission of official papers to Group 1600 is (703) 308-4242. Draft or informal FAX communications should be directed to (571) 273-0942. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman
Patent Examiner
Art Unit 1652

 06-11-04